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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,513	04/09/1999	PHILIP R. WISER	P-2090	8705

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EXAMINER	
GILLIGAN, CHRISTOPHER L	
ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/289,513	WISER ET AL.	
	Examiner	Art Unit	
	Luke Gilligan	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *51-54,56-64 and 71-76* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *51-54,56-64 and 71-76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/21/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Response to Amendment

1. In the amendment filed 6/16/06, the following has occurred: claims 51, 52, 53, and 57 have been amended; claims 65-70 have been canceled; claims 71-76 have been added. Now, claims 51-54, 56-64, and 71-76 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 51-52, 54, 56-57, 71-72, and 74-76 are rejected under 35 U.S.C. 102(e) as being anticipated by Payne et al., U.S. Patent No. 5,5715,314.

4. As per claim 51, Payne et al. teach a method for conducting electronic commerce through a computer network, the method comprising: receiving, in a merchant computer system of the computer network, a purchase request for a digital product (see column 5, lines 26-29, payment computer of Payne et al. is read upon by the merchant system); receiving payment data in the merchant computer system wherein the payment data specifies remuneration for the digital product (see column 5, lines 29-34, this step is preformed by the payment computer of Payne et al.); sending a request for reservation of the digital product to a content manager computer system which is coupled to the merchant computer system through the computer network (see column 7, lines 31-33, merchant computer of Payne et al. is read upon by the content manager, the request includes a request to reserve access to the digital document for a

specified duration of time; the two computers are coupled via network 10 of Payne et al, see figure 1); forming by the content manager computer system transaction data which include (i) transaction identification data (see column 5, lines 30-31), (ii) product identification data which identifies the digital product (see column 5, lines 30-31), and (iii) binding data which binds the transaction to the client computer system (see column 5, lines 40-41, i.e. the buyer network address); sending the formed transaction data from the content manager computer system to the merchant computer system (see column 5, lines 48-56); receiving, in the content manager computer system a delivery request signal from the merchant computer system wherein the delivery request signal requests delivery of the digital product to a client computer system through the computer network to a client computer system which can be different from the buyer computer system (see column 7, lines 31-39, the delivery request is sent from the payment computer to the merchant computer via the buyer computer); sending the transaction identification data to the client computer system wherein the transaction identification data identifies the digital product and represents remuneration in accordance with the payment data (see column 7, lines 18-24 and lines 31-32);

5. As per claim 52, Payne teaches the method of claim 58 as described above. Payne further teaches receiving, in a delivery computer system of the computer network, the transaction identification data from the client computer system (see column 7, lines 32-33); determining within the delivery computer system, in accordance with the transaction identification data, the digital product (see column 7, lines 27-33); and sending, from the delivery computer system, the digital product to the client computer system (see column 7, lines 46-50); and sending, from the delivery computer system to the content manager computer system, a signal indicating that sending the digital product to the client computer system is completed (see column 3, lines 24-27).

6. As per claim 54, Payne teaches the method of claim 51 as described above. Payne further teaches requesting reservation by the merchant computer system comprises: encrypting data representing a requested reservation (see column 1, lines 59-64); sending the data as encrypted to the content manager computer system (see column 1, line 64 – column 2, line 2); and decrypting the data within the content manager computer system (see column 1, line 64 – column 2, line 2, the data has to be decrypted to be viewed).

7. As per claim 56, Payne teaches the method of claim 51 as described above. Payne further teaches the delivery request signal includes the transaction identification data (see column 7, lines 31-39).

8. As per claim 57, Payne teaches the method of claim 52 as described above. Payne further teaches the transaction identification data, as received by the delivery computer system is certified as originating from the client computer system (see column 5, line 66 – column 6, line 2).

9. Claims 71-72, and 74-76 recite substantially similar limitations to those already addressed in claims 51-52, 54, and 56-57 and, as such, are rejected for similar reasons as given above.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 58-59 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al., U.S. Patent No. 5,5715,314 in view of Fulton et al., U.S. Patent No. 6,182,052.

12. As per claim 58, Payne et al. teach a method for conducting electronic commerce through a computer network, the method comprising: receiving, in a merchant computer system of the computer network, a purchase request for a digital product (see column 5, lines 26-29, payment computer of Payne et al. is read upon by the merchant system); receiving payment data in the merchant computer system wherein the payment data specifies remuneration for the digital product (see column 5, lines 29-34, this step is preformed by the payment computer of Payne et al.); sending a request for reservation of the digital product to a content manager computer system which is different from the merchant computer system and which is coupled to the merchant computer system through the computer network (see column 7, lines 31-33, merchant computer of Payne et al. is read upon by the content manager, the request includes a request to reserve access to the digital document for a specified duration of time; the two computers are coupled via network 10 of Payne et al, see figure 1); receiving, in the content manager computer system a delivery request signal from the merchant computer system wherein the delivery request signal requests delivery of the digital product to a client computer system through the computer network (see column 7, lines 31-39, the delivery request is sent from the payment computer to the merchant computer via the buyer computer); sending transaction identification data to the client computer system wherein the transaction identification data identifies the digital product and represents remuneration in accordance with the payment data (see column 7, lines 18-24 and lines 31-32); receiving, in a delivery computer system of the computer network, the transaction identification data from the client computer system (see column 7, lines 32-33); determining within the delivery computer system, in accordance with the transaction identification data, the digital product (see column 7, lines 27-33); and sending, from the delivery computer system, the digital product to the client computer system (see column 7, lines 46-50).

13. Payne does not explicitly teach that the transaction identification data is sent from the content manager computer system to the client computer system. However, Fulton teaches sending transaction identification data from a content manager computer system to a client computer system, wherein the transaction identification data identifies the digital product and represents remuneration in accordance with the payment data (see column 11, lines 44-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such a feature into the system of Payne. One of ordinary skill in the art would have been motivated to incorporate such a feature for the purpose of further enhancing security provided to users of the system (see column 4, lines 37-44 of Fulton).

14. As per claim 59, Payne in view of Fulton teaches the method of claim 58 as described above, further comprising: sending, from the delivery computer system to the content manager computer system, a signal indicating that sending the digital product to the client computer system is completed (see column 3, lines 24-27).

15. As per claim 61, Payne in view of Fulton teach the method of claim 58 as described above. Payne further teaches requesting reservation by the merchant computer system comprises: encrypting data representing a requested reservation (see column 1, lines 59-64); sending the data as encrypted to the content manager computer system (see column 1, line 64 – column 2, line 2); and decrypting the data within the content manager computer system (see column 1, line 64 – column 2, line 2, the data has to be decrypted to be viewed).

16. As per claim 62, Payne in view of Fulton teach the method of claim 58 as described above. Payne further teaches in response to requesting reservation by the merchant computer system, the content manager computer system effects such a reservation of the digital product by: forming transaction data which include (i) the transaction identification data, (ii) product identification data which identifies the digital product, and (iii) binding data which binds the

transaction to the client computer system (see column 5, lines 30-44); and sending the transaction data to the merchant computer system (see column 5, lines 48-53).

17. As per claim 63, Payne in view of Fulton teach the method of claim 58 as described above. Payne further teaches the delivery request signal includes the transaction identification data (see column 5, lines 27-44).

18. As per claim 64, Payne in view of Fulton teach the method of claim 58 as described above. Payne further teaches the transaction identification data, as received by the delivery computer system is certified as originating from the client computer system (see column 5, line 42, particularly the "buyer network address").

19. Claims 53 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al., U.S. Patent No. 5,5715,314 in view of Stefik et al., U.S. Patent No. 6,236,971.

20. As per claim 53, Payne teaches the method of claim 52 as described above. Payne et al. do not explicitly teach encrypting the digital product before sending it to the client computer system and then decrypting it once in the client computer system. Stefik et al. teach encrypting the digital product with a created encrypting key before sending it to the client computer system and then decrypting it once in the client computer system (see column 26, lines 39-52, column 37, lines 40-43 and lines 57-62). Stefik further teaches discarding the new encryption key (see column 37, lines 40-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the encrypting element of Sefik et al. with the electronic commerce method of Payne et al. for the purpose of providing increased security to users of the system.

21. Claim 73 recites substantially similar additional limitations to those already addressed in claim 53 and, as such, is rejected for similar reasons as given above.

22. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al., U.S. Patent No. 5,5715,314 in view of Fulton et al., U.S. Patent No. 6,182,052 and further in view of Stefik et al., U.S. Patent No. 6,236,971.

23. As per claim 60, Payne et al. in view of Fulton teach the method of claim 58 as described above. Payne et al. do not explicitly teach encrypting the digital product before sending it to the client computer system and then decrypting it once in the client computer system. Stefik et al. teach encrypting the digital product with a created encrypting key before sending it to the client computer system and then decrypting it once in the client computer system (see column 26, lines 39-52, column 37, lines 40-43 and lines 57-62). Stefik further teaches discarding the new encryption key (see column 37, lines 40-43). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the encrypting element of Sefik et al. with the electronic commerce method of Payne et al. for the purpose of providing increased security to users of the system.

Response to Arguments

24. In the remarks filed 6/16/06, Applicant argues in substance that (1) the previous Office Action failed to address the fact that in claim 58, the transaction identification data is sent from the content manager computer system to the client computer system; (2) Payne fails to teach sending formed transaction data, nor any other data, from a content manager computer system to a manager computer system.

25. In response to Applicant's argument (1), the Examiner agrees with Applicant's assertion and, accordingly, has withdrawn the previous 102(e) rejection in view of Payne alone. However, the Examiner has relied upon a new grounds of rejection in view of Payne in view of Fulton as

detailed above. Therefore, this argument is now moot in view of the new grounds of rejection detailed above.

26. In response to Applicant's argument (2), although the Examiner agreed in the interview on 5/18/06 that the Amendment to claim 51 appeared to overcome the previous grounds of rejection, it is respectfully submitted that, upon further consideration of the teachings of Payne, that this limitation is taught by the reference. In particular, in an alternative embodiment, Payne describes forming, in the content manager computer system (merchant computer in Payne), transaction data that includes those pieces of data recited in the claim (see column 5, lines 30-41) and sending this data to the merchant computer (payment computer in Payne) via the buyer computer (see column 5, lines 41-48). Therefore, it is respectfully submitted that Payne teaches this limitation as detailed above.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9/1/06

C. LUKE GILLIGAN
PATENT EXAMINER